



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,309	05/19/2006	Gabriele Balboni	2525-1019	4489
466	7590	02/25/2009	EXAMINER	
YOUNG & THOMPSON			FAYYAZ, NASHMIYA SAQIB	
209 Madison Street			ART UNIT	PAPER NUMBER
Suite 500			2856	
ALEXANDRIA, VA 22314				

  

MAIL DATE	DELIVERY MODE
02/25/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<i>Office Action Summary</i>	Application No.	Applicant(s)
	10/576,309	BALBONI, GABRIELE
	Examiner	Art Unit
	Nashmiya S. Fayyaz	2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 December 2008.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-92 and 94 is/are pending in the application.  
 4a) Of the above claim(s) 14-92 and 94 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-13 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1.) Certified copies of the priority documents have been received.  
 2.) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/19/06</u> .   | 6) <input type="checkbox"/> Other: _____ .                        |

DETAILED ACTION

*Election/Restrictions*

1. Applicant's election with traverse of Group I in the reply filed on 12/5/08 is acknowledged. The traversal is on the ground(s) that the groups are so intimately interrelated that no undue burden is placed on the examiner. This is not found persuasive because undue burden does exist since the search required for each group is not necessarily required for the other groups. Also, mere consideration for restriction purposes does not constitute a thorough search on the merits of the claims.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 14-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/5/08.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, on line 2, recitations

of “such as” and “and the like” are indefinite since the scope of the claim cannot be determined. On line 3, it is unclear how the apparatus comprises “means for supporting the apparatus”. On line 4, “the respective ends” and “the measuring ends” lacks antecedent basis. On line 5, “the instrument” lacks clear antecedent basis. Also, on line 5, “these means” lacks clear antecedent basis. On line 8, “it” is unclear. On line 12, “its” is unclear. In claim 4, on line 2, “the blocks” lacks antecedent basis. Also, it is unclear how the blocks “mount the contact means”. In claim 5, on line 2, “it” is unclear. In claim 8, on line 2, “it” is unclear. On line 3, “the fixed block” lacks antecedent basis. In claim 9, “the fixed block” lacks antecedent basis. In claim 12, on line 3, “the fixed end blocks” lacks antecedent basis.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunnen-US Patent # 3,496,758. As to claim 1, as best understood, Sunnen discloses a bore gauge setting fixture including bore gauge 12, means for supporting (base 50 with pedestals 52/54), contact means (fixture surface 66 and surface 76), first/second surface(42/28), see col. 2, lines 71 et seq and figs. 1-5. Further, Sunnen does not disclose an adapter element, per se. However, Sunnen does disclose an adjustment extension member 100 which is designed to receive and support an end of the gauge based on its profile. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have designated the adjustment extension member as an adapter element since it performs the functions of the adapter element as disclosed. As to claim 2, note fixed block (anvil 58 fixed with set screw 62a). As to claim 3, note mobile block (shaft 122) supports the other end via member 100. As to claim 4, note fig. 1 and 2 showing horizontal alignment. As to claim 5, note knurled knob 126 as a means for driving. As to claim 6, note clamping member 102 which guides. As to claim 7, note guide shaft 104. As to claim 8, as best understood, note fixed mounting block (platform 78 or pedestal 54). As to claim 9, note fig. 1 depiction. As to claim 10, note knurling 124 as a means for driving.

As to claims 11-12, note drive shaft 122 with threading within sleeve 118 for rotation. As to claim 13, note knurl knob 126 or micrometer 120 for controlling.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the prior art to Rutter et al and Czaplinski et al which depict similar setting devices for bore gauges including a movable and stationary contact.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashmiya S. Fayyaz whose telephone number is 571-272-2192. The examiner can normally be reached on Tuesdays and Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron E. Williams can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. S. F./  
Examiner, Art Unit 2856  
/Hezron Williams/  
Supervisory Patent Examiner, Art Unit 2856